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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
YUAN, ALMARI ROMERO

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/339,634	COTTRILLE ET AL.
	Examiner	Art Unit
	Almari Yuan	2176

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 02 October 2003.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-19 is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-19 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed on 9/15/03 and Request

for RCE filed on 10/02/03.

2.   The rejection of claim 7 under 35 U.S.C. 102(b) as being anticipated by van Hoff has

been withdrawn as necessitated by amendment.

3.   The rejection of claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over van Hoff in view of Van Der Meer has been withdrawn as necessitated by

amendment.

4.   Claims 1-19 are pending in the case. Claims 1, 7, and 16 are independent claims.

Continued Examination Under 37 CFR 1.114

5.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 10/02/03 has been entered.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff (USPN 5,822,539 - filed on 12/1995) in view of "Scope of the Annotation Protocol", 12/1995, <http://www.hypernews.org/~liberte/www/annotation-protocol-design> , pages 1-3 (herein after "Annotation Protocol").**

Regarding independent claim 7, van Hoff discloses:

A scalable method of retrieving an annotation associated with a content source, the method comprising:

sending a document identifier associated with a content source to a tier I server, said tier I sever being part of a multiple tier hierarchal annotation server system that also includes a tier II server (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-57, see figure 2: teaches annotation with a unique identifier to retrieve requesting document; annotations are retrieved from an annotation proxy (tier server I) and document retrieved from a web server (tier server II)); and

if an annotation is associated with the document identifier, receiving a reference from said tier I server to said tier II server, said tier II server maintaining additional information regarding the annotation associated with the document identifier (van Hoff on col. 5, lines 1-32, col. 6, lines 34-57 and lines 65-67, see figure 2: teaches the annotation proxy server (tier I) receives the client requests, each annotations are uniquely identified to be associated with requesting document which can be located and retrieved from a web server (tier server II); each document is identifiable by a unique document identifier to identify document stored in server

104; the proxy server applies the identified annotation directory to the received document to add

annotation).

However, van Hoff does not explicitly disclose "tier I server storing minimal information

regarding annotations associated with said content source, said minimal information including

the existence of annotations associated with said content source and the identification of said tier

II server if said annotations exist".

Annotation Protocol discloses an annotation server may serve annotations for several

distinct sets of URLs; subsets and supersets may be on different servers (on page 2, 1st

paragraph); the annotation servers should be able to offer information to clients about all the

URLs that have annotations or may have annotations so that clients using a scalable lookup of

annotations (on page 2, 4th paragraph).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have modified Annotation Protocol into van Hoff to provide sets of URLs

on different servers and determining if annotation exist using a scalable lookup of annotations, as

taught by Annotation Protocol, incorporated into the multiple server environment, as taught by

van Hoff, in order for the user to avoid making requests to the server that has no annotations in

the set.

8.   **Claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

van Hoff (USPN 5,822,539 - filed on 12/1995) in view of Van Der Meer (USPN 6,289,362 B1

- filed on 9/1998), and in further view of "Scope of the Annotation Protocol", 12/1995,

<http://www.hypernews.org/~liberte/www/annotation-protocol-design> , pages 1-3 (herein

after "Annotation Protocol").

Regarding independent claim 1, van Hoff discloses:

A scalable method of storing an annotation associated with a content source, the method

comprising:

representing an annotation having a plurality of properties wherein one of the plurality of

properties is a document identifier (van Hoff on col. 5, lines 1-32: teaches annotation having a

unique identifier);

the document identifier identifying the content source with which the annotation is

associated (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-57, see figure 2: teaches associating

annotation with requesting document; annotations are retrieved from an annotation proxy

server);

storing the annotation on the servers of a multiple tier hierarchical annotation server system

wherein the information about the annotation but not the annotation is stored on a lower tier

server and the annotation is stored on a higher tier server (van Hoff on col. 3, lines 4-21, col. 6,

line 65 – col. 7, line 1, and col. 8, line 64 – col. 9, line 2, see figure 2: teaches annotations stored

in the annotation proxy server; wherein the documents associated with stored annotations are

stored in the web server to be retrieved. In figure 2, shows the multiple tier network system

comprising the web client 102, annotation proxy server 118, 119, and web servers 104a, 104b,

and 104c; not shown but discloses on col. 5, lines 24-26, the requested document and any cross-

referenced document can be on the same or different servers 104, at any web sites anywhere).

However, van Hoff does not explicitly disclose, "annotation as an object".

Van Der Meer on col. 2, lines 44-52: teaches object including annotation.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

However, van Hoff and Van Der Meer do not explicitly disclose "storing the annotation and information about the annotation accessible using the document identifier".

Annotation Protocol discloses an annotation server may serve annotations for several distinct sets of URLs; subsets and supersets may be on different servers (on page 2, 1st paragraph); annotation server stores annotations (on page 2, 3rd paragraph); attributes of an annotation will be given a URL (on page 2, 5th paragraph).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Annotation Protocol into van Hoff and Van Der Meer, to provide an annotation server for storing annotations and attributes of an annotation is given a URL, as taught by Annotation Protocol, incorporated into the multiple server environment, as taught by van Hoff and Van Der Meer, in order to facilitate the creation and retrieval of annotations.

Regarding dependent claim 2, Van Der Meer discloses:

wherein the act of representing the annotation as an object having a plurality of properties further comprises defining generic properties of the annotation (Van Der Meer on col. 11, lines 25-32: teaches define annotation e.g. link data, expiration data, etc.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 3, Van Der Meer discloses:

wherein the generic properties are selected from the group consisting of type, content, author name, creation time, modify time, time to-live, document identifier, index and parent identifier (Van Der Meer on col. 11,lines 25-32: teaches define annotation e.g. link data, expiration data, etc., (which may include creation time, modify time, etc.)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 4, Van Der Meer discloses:

wherein the type property of the annotation is selected from the group consisting of: a text file, a threaded message, an audio file, a video file, a calendar file, and a chat (Van Der Meer on 4, lines 37-60: teaches objects as cartoon characters, company advertisements, etc.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server

which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 5, van Hoff discloses:

wherein the act of representing the annotation as a object having a plurality of properties further comprises define one or more type specific properties unique to the type property of the annotation (van Hoff on col. 5, lines 1-32: teaches annotations having a unique identifiers) and (Van Der Meer on col. 11,lines 25-32: teaches define annotation e.g. link data, expiration data, etc. (different types of properties).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 6, van Hoff discloses:

wherein the document identifier is selected from the group consisting of: a file name, a directory path, and a uniform resource locator (van Hoff on col. 2, lines 1-26: teaches unique identifier as an URL).

Regarding dependent claims 8 and 9, van Hoff discloses:

displaying the first response in a manner that is non-intrusive or intrusive to the content source (van Hoff on col. 3, lines 17-21: teaches annotation proxy server similar to a firewall proxy (to filter non-intrusive or intrusive requested documents)).

Regarding dependent claim 10, van Hoff discloses:

sending a request to the tier II server for additional information regarding the annotation

associated with the content source; and receiving a response from the tier II server, said response

comprising at least property of the annotation (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-

57, see figure 2: teaches the web server (tier II server) containing requested documents or other

information to be associated with annotations retrieved from an annotation proxy server), storing

the annotation associated with the document identifier (van Hoff on col. 5, lines 1-32, col. 6,

lines 34-57 and lines 65-67, see figure 2: teaches each document is identifiable by a unique

document identifier to identify document stored in server 104; the proxy server applies the

identified annotation directory to the received document to add annotation, in other words, the

annotation is associated with the document based on its unique document identifier).

However, van Hoff does not explicitly disclose, "reference to a tier III server".

Van Der Meer on col. 4, lines 37-60: teaches a presentation context server (not shown in

figure 1) (as tier III server) in communication with the diary server (tier II sever).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have modified Van Der Meer into van Hoff to provide a presentation

context server (not shown in figure 1) (as tier III server) incorporated as a different type of server

in communication with the web server (tier II) containing documents and other information to be

associated with annotations which will enhance the presentation of data by controlling the data

displayed to the user.

Regarding dependent claims 11 and 12, van Hoff discloses:

further comprising displaying the at least one property of the annotation in a manner that is

non-intrusive or intrusive to the content source (van Hoff on col. 3, lines 17-21: teaches

annotation proxy server similar to a firewall proxy (to filter non-intrusive or intrusive requested documents)).

Regarding dependent claim 13, Van Der Meer discloses:

sending to tier III server an annotation identifier for the annotation associated with the content source; and receiving a third response from the tier III server, wherein the third response comprises the annotation identified by the annotation identifier annotation (Van Der Meer on col. 4, lines 9-60: teaches a presentation context server (not shown in figure 1) (as tier III server) in communication with the diary server (tier II sever) to retrieve template associated with the object including annotation).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide a presentation context server (not shown in figure 1) (as tier III server) incorporated as a different type of server in communication with the web server (tier II) containing documents and other information to be associated with annotations which will enhance the presentation of data by controlling the data displayed to the user.

Regarding dependent claims 14 and 15, van Hoff discloses:

further comprising displaying the annotation identified by the annotation identifier in a manner that is non-intrusive or intrusive to the content source (van Hoff on col. 3, lines 17-21: teaches annotation proxy server similar to a firewall proxy (to filter non-intrusive or intrusive requested documents)).

Regarding claims 16-19, the limitations of claims 16-19 are a computer readable medium for processing the method of claims 1-6 and 8-15 and are rejected under the same rationale.

Response to Arguments

9.   Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is (703) 305-5945. The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

AY
December 14, 2003

JOSEPH H. FEILD
PRIMARY EXAMINER